United States Patent and Trademark Office

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,039	09/21/2000	Jacob Y. Wong	JSF 35.0011	8402

7590   10/07/2003

Roy L. Anderson
LAW OFFICES OF ROY L. ANDERSON
1010 NORTH CENTRAL AVENUE
GLENDALE, CA 91202

EXAMINER
HESS, DANIEL A

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/667,039	WONG ET AL.	
	Examiner	Art Unit	
	Daniel A Hess	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>12 August 2003</u> .

2a) ☒ This action is **FINAL**.　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-10,12-16 and 18-22</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) <u>12-16 and 18-22</u> is/are allowed.

6) ☒ Claim(s) <u>1-10</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Remarks

1.   Acknowledgement is made of amendment dated 8/12/2003, which has been placed in the

file of record, and to which this action is a reply.

2.   Please see specifically the *Response to Arguments* section below. The rejections applied

below remain generally unchanged, and that section gives some explanation.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5.   Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,068,192) in view of Neustein (US 5,192,947).

Re claim 1: McCabe shows (column 5, lines 45-50) an electronic card that in addition has multiple electronic stripes. There is an account number (column 4, line 54) on the card. It is clear that if the card is to be used in swipe transactions, as is typical, this number must also be stored in the stripe, although it is not explicitly stated. The card is a credit card type (column 5, lines 60-65). Therefore each transaction request must submit data, including the account number, to a money source for approval of the payment card transaction. There is a data packet therefore that includes at least the credit account number.

McCabe fails to show the transmission of either a user id or a data packet that is separate from the credit account number.

Neustein shows (abstract, lines 10-13) an electronic device used in credit card transactions which has a magnetic stripe containing, in addition to ID data, **security data** as well as standard account info for a credit card applicant. The identification and security data are the additional data that McCabe lacks. See Neustein, column 5, lines 10-25 for an additional description of this data.

In view of Neustein's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known security data pack as taught by McCabe in transactions because this provides for a more secure exchange.

Re claim 2: McCabe, as noted above, has a magnetic stripe.

Re claim 3: McCabe has (column 5, lines 48-50) three tracks on his card. Although he does not discuss what data goes on which track, the selection of a particular track does not make a material difference.

6.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe as modified by Neustein as applied to claim 1 above, in further view of Gutman et al (US 5,834,756, of record in the IDS).

McCabe as modified by Neustein fails to show that the data pack is generated within the processor and then conveyed to the magnetic stripe.

Gutman (see abstract) teaches having data originate in the processor and then be transferred to a magnetic stripe. The magnetic stripe is thus dynamically dependent on the data in the card.

In view of Gutman's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known origination of a data pack in the processor of a smart card because this could permit the card to act as a multipurpose card, generating several different credit cards data according to different accounts held by the user. Alternatively, this could permit the origination of one-time-use transaction numbers as taught by Eisel (US 4,849,613, of record in IDS). Eisel is discussed below.

7.   Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe as modified by Neustein and Gutman as applied to claim 4 above, in further view of Lamensdorf

(US 5,568,121). The teachings of McCabe as modified by Neustein and Gutman as applied to claim 4 have been discussed above.

McCabe fails to show that the smart card executes a program to check battery life and then generates a warning signal if battery life is low.

Neustein (column 5, lines 59-61) that there is an indicator of a low battery on a card. Neustein does not show how this is achieved.

Lamensdorf (column, lines 20-28) shows how a low battery is detected: a program monitors power and creates a low battery signal.

In view of the teachings of Neustein and Lamensdorf, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known executed of a program to check battery life and then generating a warning signal if battery life is low as taught by Neustein and Lamensdorf into the teachings of McCabe because this can allow the user to replace a card before the power runs out.

8.   Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe as modified by Neustein as applied to claim 1 above, and further in view of Eisel (US 4,849,613). The teachings of McCabe as modified by Neustein as applied to claim 1 have been discussed above.

Re claims 7-9: McCabe as modified by Neustein fails to teach or suggest the use of a one-time use transaction number transaction number initiated by the user.

Eisel shows (column 2, lines 36-56; especially lines 51-55) the generation of a one-time-use transaction number for financial transactions with the use of a single function key.

In view of Eisel's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known custom-generated transaction number as taught by Eisel in the teachings of McCabe as modified by Neustein because this can be helpful for preventing forgery.

Re claim 10: See Eisel's discussion of sequence numbers (column 5, lines 18-28) which form the basis for how the above one-time-use numbers are generated.

Allowable Subject Matter

9.   Claims 12-16, 18-22 are allowed.

The following is an examiner's statement of reasons for allowance:

Re claim 12-16 and 18-21: McCabe shows the following: There is an account number (column 4, line 54) on the card. It is clear that if the card is to be used in swipe transactions, as is typical, this number must also be stored in the stripe, although it is not explicitly stated. The card is a credit card type (column 5, lines 60-65). Therefore each transaction request must submit data, including the account number, to a money source for approval of the payment card transaction, as well as a user account number in an approval process.

McCabe fails to show that the smart card executes a program to check battery life and then generates a warning signal if battery life is low.

Neustein shows (column 5, lines 59-61) that there is an indicator of a low battery on a card. Neustein does not show how this is achieved.

Lamensdorf (column, lines 20-28) shows how a low battery is detected: a program monitors power and creates a low battery signal.

In view of the teachings of Neustein and Lamensdorf, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known executed of a program to check battery life and then generating a warning signal if battery life is low as taught by Neustein and Lamensdorf into the teachings of McCabe because this can allow the user to replace a card before the power runs out.

However, the second part of step 3, was not found in the prior art of record. The examiner did not find any art showing submitting a low battery signal to a money source in connection with a transaction approval process.

Re claim 22: The examiner did not find within the art, and Eisel does not teach, that the sequence number used for generating the one-time use credit card number originates in a particular security data packet of the type discussed in the earlier claims upon which claim 11 depends.

10.   Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

11.   Applicant's arguments filed 8/12/2003 have been fully considered but they are not persuasive. Firstly, the term 'data packet' is a very broad term that is not narrowed appreciably in the language of the claim. Secondly, regarding the applicant's argument that the data packet of McCabe as modified by Neustein is not stored dynamically into the stripe as part of the transaction, the examiner respectfully agrees but notes that nowhere in the claim language is this conveyed. The claim states that a data packet is stored in a magnetic medium of a card – but every card has data stored in the stripe at some time or other. The applicant notes that "McCabe as modified by Neustein fails to show that the data packet is generated within the processor and then conveyed to the magnetic stripe." But none of claims 1-3 include the limitation that the data packet is generated within the processor.

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

13.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

14.   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.
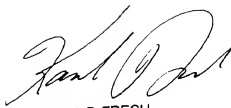
Daniel A Hess

Art Unit: 2876

DH

Examiner
Art Unit 2876

KARL D. FRECH
PRIMARY EXAMINER